

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

MAILED

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PATENT OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte INBAE YOON

Appeal No. 95-1382
Application 08/063,486¹

ON BRIEF

Before LYDDANE and FRANKFORT, Administrative Patent Judges, and
CRAWFORD, Acting Administrative Patent Judge.
CRAWFORD, Acting Administrative Patent Judge.

DECISION ON APPEAL

This an appeal from the examiner's rejection of claims 46 and 47 under 35 U.S.C. § 112, first paragraph, and under 35 U.S.C. § 102(b). The following claims are on appeal:

¹ Application for patent filed May 19, 1993. According to applicant, this application is a continuation of Application 07/596,937 filed October 15, 1990, which is a continuation-in-part of Application 07/222,776 filed July 22, 1988, abandoned.

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46. A medical instrument for manipulating internal organs of a body, comprising:

a rod, having a retractor body arranged at a distal end of a [sic, the] rod and a handle at a proximal end of the rod;

a rigid flexion resisting shaft, having a proximal end and a distal end, for guiding said rod, said rod being movable with respect to the shaft in an axial direction of said rod;

wherein said retractor body comprises a multi-joint lever system of articulated arms connected to one another to be pivotably movable, which can be brought into an open position by movement of the rod in a first direction with respect to the shaft, and can be brought into a closed position by movement of the rod in a second direction with respect to the shaft.

47. A manipulator according to claim 46 wherein said multi-joint lever system comprises two pairs of articulated arms, each pair having a proximal end, a distal end and a central joint where two articulated arms are joined by a hinge, each pair being assigned to an opposite side of said rod guided by said shaft, said distal end of each pair being pivotally connected to said distal end of said rod and said proximal end of each pair being pivotally connected to said distal end of said shaft.

The examiner relies on the following reference:

Regenbogen	3,495,586	Feb. 17, 1970
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Appellant claims a medical instrument for manipulating various tissue and organ structures of a human body such as the uterine, abdominal and cranial structures. Claims 46 and 47 were copied from U.S. Patent No. 5,113,846 to Hildebrandt et al. (hereinafter, Hildebrandt) to provoke an interference. As depicted in Figure 37, the embodiment on which appellant considers claims 46 and 47 to be readable, the instrument includes a first tubular member 424 which telescopically receives a second tubular member 420. At one end of the first tubular

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member 424 is a resilient triangular spring member 110 which has arms or legs 110a, 110b and 110c which form the triangle. The specification states that the "base leg 110c is pivotably mounted at its midsection 118 to the distal end of tubular member 420, and the lateral legs 110a and 110b are pivotably mounted to the base leg 110c by flexible joints 120 to permit relative movement of the respective legs and base leg incident to displacement of the tubular member 420 in the direction of the arrow". (page 23, lines 2-9).

The examiner has objected to the specification as not providing support for claims 46 and 47 under 35 U.S.C. § 112, first paragraph and has rejected claims 46 and 47 under 35 U.S.C. § 112, first paragraph. Specifically, the examiner found that the specification does not support the recitation of "a multi-joint lever system comprising articulated arms connected to one another to be pivotably movable" (page 2 of the rejection dated Aug. 19, 1993, Paper No. 4) as recited in claim 46. The examiner also found no support for (1) "each pair having a proximal end, a distal end and a central joint where two articulated arms are joined by a hinge" and (2) "said distal end of each pair being pivotally connected to said distal end of said rod and said proximal end of each pair being pivotally connected to said distal end of said shaft" as recited in claim 47.

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The appellant correctly interprets the rejection of the examiner as a rejection based on a lack of written description of the invention in the specification. The purpose of the written description requirement is to ensure that the inventor had possession of the invention as of the filing date. In re Wertheim, 541 F.2d 257, 263, 191 USPQ 90, 97 (CCPA 1976). When claims are copied to provoke an interference, the application must clearly support the claim limitations. Brand v. Thomas, 96 F.2d 301, 304, 37 USPQ 505, 508 (CCPA 1938); Martin v. Mayer, 823 F.2d 500, 503; 3 USPQ2d 1333, 1336 (Fed. Cir. 1987).

Initially we note that the system disclosed by appellant (as well as by Hiltebrandt) is not a lever system in the traditional sense as there is no rigid rod that pivots about a fulcrum. Appellant argues that the claims use the same language as Hiltebrandt to describe the same structure operating in the same way. It is true, as appellant argues, that the claims copied from Hiltebrandt should be interpreted in view of Hiltebrandt in determining the meaning of the term "lever". In re Spina, 975 F.2d 854, 856, 24 USPQ2d 1142, 1144 (Fed. Cir. 1992). Hiltebrandt discloses that the retractor thereof has four arms 9, 10, 11 and 12 and that these arms are connected so as to form an articulated linkage system with arms that are pivotally movable. However, Hiltebrandt calls this system a "lever system". See, for example, column 2, lines 6-13 of Hiltebrandt.

In our view, appellant does disclose a lever system similar to that broadly defined by Hiltebrandt's disclosure.

The arms 110(a), 110(b) and 110(c) depicted in appellant's Figure 37 clearly are articulated arms as arms 110(a) and the first part of 110(c) are pivotably connected and the second part of 110(c) and 110(b) are pivotably connected. Although arms 110(a) and 110(b) are disclosed as being pivotably connected to arm 110(c) and arm 110(c) is disclosed as being pivotably connected at midsection 118 to tubular member 420, there is no specific disclosure as to how much the various arms pivot. As correctly noted by appellant, the arms 110(a) and 110(b) cannot pivot unless arm 110(c) has two sections or bends. The written description does not disclose that leg 110(c) has two sections. However as retractor 110 is disclosed as a resilient spring member, we find that 110(c) bends as least to some extent providing a first position as depicted in Figure 37 and a second position wherein the resilient triangular member is retracted at least to some degree as rod 420 is moved distally. The disclosure clearly supports that member 110 retracts to some degree because it is disclosed as a resilient member. This is supported further by the disclosure that the circular member in Figure 36, which is also a resilient spring member, bends to fit within the outer tube 424. Therefore, we find that appellant's

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disclosure supports a multi-joint lever system with articulated arms to be pivotably movable. Claim 46 does not require the pivotable movement to be about pivot pins, hence the flexing permitted by the spring member 110(c) to permit extension and retraction as disclosed would provide the claimed pivotable movement.

Turning to claim 47, appellant's specification broadly discloses two pairs of arms: (1) 110(a) and a first part of 110(c) which are pivotably connected and (2) 110(b) and a second part of 110(c) which are pivotably connected. Since 110(c) is a resilient spring member, we find that some pivoting about rod 420 will occur when rod 420 is extended thereby straightening to at least some degree member 110(c). We also find that joints 120 are disclosed as flexible joints and would allow the arms to pivot and therefore are broadly a hinge. In the final analysis, we find that there is support in the disclosure for the claimed subject matter of claims 46 and 47 and thus we reverse the examiner's rejection on this ground.

In addition, the examiner rejected claims 46 and 47 under 35 U.S.C. § 102(b), as anticipated by Regenbogen. We initially observe that an anticipation under 35 USC 102(b) is established when a single prior art reference discloses, either expressly or under the principles of inherency, each and every element of a claimed invention. See RCA Corp. v. Applied Digital

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Data Systems, Inc., 730 F.2d 1440, 1443, 221 USPQ 385, 388 (Fed. Cir. 1984), cert. dismissed sub nom., Hazeltine Corp. v. RCA Corp., 468 U.S. 1228 (1984). Additionally, the law of anticipation does not require that the reference teach what the appellant is claiming, but only that the claims on appeal "read on" something disclosed in the reference, i.e., all limitations of the claim are found in the reference. See Kalman v. Kimberly Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983) cert. denied, 465 U.S. 1026 (1984) (and overruled in part on another issue) 775 F.2d 1107, 227 USPQ 577 (Fed. Cir. 1985).

Regenbogen discloses a medical instrument which is utilized to manipulate internal organs of a body which includes a rigid outer rod 10 and an inner rod 11. The inner rod 11 is retractable by manipulating handles 10' and 11'. Arms 12 are pivotably connected to each other and rod 10 at a joint 13 and pivotably connected to outer rod 10 at 14. Regenbogen also discloses that inner rod 11 is movable in an axial direction with respect to the shaft 10 wherein movement in one direction opens the retractor arms (Fig. 3) and movement in the opposite direction closes the retractor arms (Fig. 2). Therefore, we agree with the examiner that Regenbogen discloses each and every element of claim 46 and we shall thus sustain the examiner's rejection of claim 46 under 35 USC 102(b).

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As to claim 47, we do not agree with the examiner that Regenbogen discloses two pairs of arms as claimed, and thus we reverse the examiner's rejection with respect to this claim.

Accordingly, the examiner's decision rejecting claims 46 and 47 under 35 USC 112, first paragraph, and rejecting claim 47 under 35 USC 102(b) is reversed, but the decision rejecting claim 46 under 35 USC 102(b) is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

WILLIAM E. LYDDANE
Administrative Patent Judge

Charles E. Frankfort
CHARLES E. FRANKFORT
Administrative Patent Judge

MURRIEL E. CRAWFORD
Acting Administrative Patent Judge)

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